

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Formerly Mohammed *et al.*
Now Sargent *et al.*

Application No. 10/566,933

Filed: February 1, 2006

FILED VIA EFS

Confirmation No. 1168

For: ARRAYS, METHODS AND KITS FOR
PREPARATION AND USE OF SYNTENIC GENOMIC
ARRAYS FOR DIAGNOSTICS AND TOXICOLOGY

Examiner:

Art Unit:

Attorney Reference No. 6395-79220-08

FILED VIA ELECTRONIC FILING SYSTEM
COMMISSIONER FOR PATENTS

PETITION UNDER 37 C.F.R. § 1.47(b)

Applicants request that the referenced application be accorded status under 37 C.F.R. § 1.47(b) because Applicants have been unable to contact Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu for their signatures on their respective Statements Under 37 C.F.R. 1.497 Regarding Inventorship (Statements). These individuals were erroneously named as inventors on PCT Application No. PCT/US2004/025124, which has entered the U.S. national stage as the referenced application (No. 10/566,933). After this application entered the U.S. national stage, its prior owner determined that Mansoor Mohammed, Jae Weon Kim, Robert C. Johnson and Xan-Yan Lu had improperly been named as inventors of the pending claims, and that inventors employed by the Centers and Disease Control and Prevention (“CDC”) should instead have been named as the inventors.

In response to a Notice of Missing Parts dated February 26, 2007, a Declaration is being submitted herewith that names the correct inventors of the claimed subject matter. A Statement Under 37 C.F.R. 1.497 Regarding Inventorship has been submitted by Robert C. Johnson, acknowledging that he was named as an inventor in the PCT application through no deceptive intent on his part. However, Applicants have been unable to contact the remaining individuals who were incorrectly named as inventors, and this Petition is therefore being filed under 37 C.F.R. § 1.47 to

request that prosecution be allowed to proceed without signed Statements from Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu (“the unavailable individuals.”)

The pertinent facts supporting the conclusion that the Applicant has been unable to contact Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu after diligent effort are evidenced by the following: This application was originally filed by Spectral Genomics, Inc. (“Spectral”) of Houston, Texas based on work performed in collaboration with CDC under a Cooperative Research and Development Agreement (“CRADA”). Spectral (or certain assets thereof) was subsequently acquired by PerkinElmer LAS, Inc. (“PE”) in May 2006, at which time PE acquired ownership of patent applications owned by Spectral. After receiving a Notice of Missing Parts for the referenced application (No. 10/566,933), PE began to investigate its inventorship. That investigation concluded that Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu and Robert C. Johnson did not contribute to the claimed subject matter as inventors, and that the correct inventors were Linda M. Sargent, Steven H. Reynolds, David T. Lowry and Michael L. Kashon, all of whom were employed by CDC (“the CDC inventors”).

After PE concluded its inventorship investigation, it notified CDC of its findings, and CDC asked the law firm representing PE to transfer the file to Klarquist Sparkman, LLP. The file was transferred to counsel for CDC on August 20, 2007 and CDC’s counsel immediately began to obtain the documents required to correct inventorship of the pending application. The signatures of the CDC inventors were obtained on the Declaration of Inventorship (submitted herewith) on September 4, 2007.

The following correspondence demonstrates that the former Spectral inventors are unavailable to sign Rule 497 Statements, after diligent efforts by CDC’s counsel to locate them:

1. Letter to PerkinElmer LAS, Inc.’s general counsel, dated September 7, 2007, which enclosed Statements for signature by Mansoor Mohammed, Robert C. Johnson, Jae Weon Kim, and Xan-Yan Lu;
2. E-mail from PerkinElmer LAS, Inc.’s general counsel, dated September 21, 2007, stating that they are unable to contact Mansoor Mohammed, Robert C. Johnson, Jae Weon Kim, and Xan-Yan Lu;

3. Letters to each of Mansoor Mohammed, Robert C. Johnson, Jae Weon Kim, and Xan-Yan Lu
Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu, sent via FedEx on September 21,
2007, to the last known addresses of each.

CDC's current counsel did not earlier attempt to obtain signatures directly from the
unavailable individuals, and attempted to first obtain them through PE, because Klarquist Sparkman,
LLP did not have permission to directly contact the unavailable individuals. In response to the letters
sent directly to Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu, a response with the signed
document has thus far only been received from Robert C. Johnson (submitted herewith).

The last known addresses of Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu, as of
February 10, 2005, are as follows.

Mansoor Mohammed
27260 Las Altos #1522
Mission Viejo, CA 92692

Jae Weon Kim
7777 Greenbriar Street #1067
Houston, TX 77030

Xan-Yan Lu
3323 Sturbridge Lane
Sugarland TX 77479

In view of the circumstances discussed above, Applicants request that the application be
allowed to proceed without the signatures of Mansoor Mohammed, Jae Weon Kim, and Xan-Yan Lu,
on their respective Statements and that the application be accorded status under 37 C.F.R. § 1.47(b).
If any questions remain, a representative of the Patent Office is requested to telephone the
undersigned.

Respectfully submitted,

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